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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,051	06/21/2000	Michael J. Witz	2043.197US1	7802

49845 7590 03/10/2010

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EXAMINER	
AKINTOLA, OLABODE	
ART UNIT	PAPER NUMBER
3691	

NOTIFICATION DATE	DELIVERY MODE
03/10/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM
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Office Action Summary	Application No.	Applicant(s)	
	09/599,051	WITZ ET AL.	
	Examiner	Art Unit	
	OLABODE AKINTOLA	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/12/2010*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 1/12/2010 has been entered.

Claim Objections

Claims 9-12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 9 which depends on claim 1 recites that the financial product is a newsletter. This does not further limit claim 1 which explicitly recites that the financial product is a mutual fund. Claims 10-12 are similarly objected to by dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, rejected under 35 U.S.C. 103(a) as being unpatentable over Reese (USPN 6236980) in view of Agarwal (USPN 6408309) and further in view of Wallman (USPN 6996539) (hereinafter referred to as "Wallman1").

Re claim 1: Reese discloses a system and method for receiving and reporting investment security recommendations from investment analyst sources, including receiving over a wide-area network (figure 3), an indication of a preference of a user from a first population of users, the first population of users is identified as investment analysts (column 12 lines 11-16, 35-38, and figure 7); aggregating preferences into a database of previously received preferences from the first

population, the aggregation being a set of preferences (figure 14, #342), and deriving a financial product for a second population from the set of preferences, the second population being associated with investors (column 2 line 40 – column 3 line 54).

Reese does not explicitly teach that the preference from the user is a selection of an investment or allocation for the investment that the user provides to the virtual community. However, the differences between the prior art and the claimed limitation are only rooted in content. And content is nonfunctional descriptive material. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate, of which there is no evidence in the record. See In re Lowry, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 1339 (Fed. Cir. 2004). See also Exparte Mathias, 84 USPQ2d 1276, 1279 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1103; 191 Fed. Appx. 959 (Fed. Circ. 2006) affirmed without written opinion Aug. 17, 2006). (Appeal brief decision mailed on 11/13/2009, page 12).

Reese does not explicitly teach that the user becomes a member of the virtual community upon completion of a personal profile; and deriving a position of a financial product (mutual fund) for a second population of users in response to the set of preferences, the second population of users identified as investors.

Agarwal teaches the concept of becoming a member of a virtual community upon completion of a profile (fig. 4, col. 5, lines 14-23 and col. 3, lines 16-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Reese to include this feature for the obvious reason of creating a virtual community of investment analyst.

Wallman1 teaches the concept of creating a portfolio of mutual funds for ordinary investors in response to a set of preferences (col. 6, lines 9-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Reese to include this feature as taught by Wallman1 for the obvious reason of creating a portfolio of mutual funds for investors.

Re claim 3: Reese teaches associating each preference with a ranking of a submitting user, and screening the preferences based on the ranking (column 30 lines 30-32 and column 21 lines 10-31).

Re claim 8: Reese teaches receiving a request for information about a mutual fund (column 15 lines 24-36, column 56 line 67). Reese fails to teach the steps of serving a page reflecting current holdings of the mutual fund.

Official notice is taken that the current holdings of a mutual fund is an old and well-known component of information about a mutual fund. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify Reese to include a display of mutual fund holdings in the mutual fund holding information report, thereby providing complete information about the mutual fund.

Re claims 9 and 12: Reese fails to teach distributing reports as an electronic newsletter, updated with a frequency greater than weekly.

Official notice is taken that the distribution of semi-weekly newsletters is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the

Applicant's invention to modify the teachings of Reese to include the distribution of a semi-weekly newsletter, because it would automate the process of a user receiving recommendation information, without the need for the user to manually retrieve the data, and since investment data can be extremely time sensitive, the newsletters would be more effective if they are distributed more frequently.

Re claim 10: Reese teaches screening the set of preferences to generate a recommendation list (column 2 lines 40-55).

Re claim 10: Reese teaches screening based on investment style of the recommended list, and generating reports based on the screening (column 57 lines 13-29).

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reese in view of Agarwal in view of Wallman1 as applied to claim 1 above, and further in view of Segal et al (USPN 6049783).

Re claim 4: Reese fails to teach identifying a subset having capitalization and a trading volume consistent with objectives of a mutual fund.

Segal teaches a method of sorting, filtering, and reporting criteria as a means for timely processing online financial data. Segal teaches criteria being selected from trading volume and capitalization (claims 15 and 18). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Reese to include the selection

criteria of trading volume and capitalization because such statistics are helpful in making investment decisions on a security.

Re claim 5: Reese teaches screening preferences based on the ranking of the submitting user (column 30 lines 30-32 and column 21 lines 10-31).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reese in view of Agarwal in view of Wallman1 as applied to claim 1 above, and further in view of Phillips et al (USPN 6473084).

Re claim 6: Reese fails to teach providing rewards based on a reward structure to submitters of high performing model portfolios.

Phillips discloses a system and method for inputting predictions of financial data. Phillips teaches ranking users who submit predictions, and providing rewards to those who repeatedly predict accurately (column 61 lines 36-53). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Reese to include the reward structure of Phillips because this feature provides motivation for analysts to most honestly recommend the securities as best they can, creating a more accurate system.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reese in view of Agarwal in view of Wallman1 as applied to claim 1 above, and further in view of Wallman (USPN 6338047) (hereinafter referred to as "Wallman2").

Re claim 7: Reese fails to teach receiving investor currency units, and establishing a new position of security in the mutual fund.

Wallman2 discloses a system and method for allowing a plurality of investors to manage investments in a mutual fund, wherein users submit preferences, and adjusting mutual fund holdings in response to these preferences (column 4 lines 5-7, 20-24, 33-40). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Reese to include establishing new investment positions in a mutual fund because based on the recommendation data of Reese, a user is able to make informed decisions about investment positions, and as the data changes, these positions may change as well, and the mutual fund should preferably reflect these changes in market conditions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Olabode Akintola/
Examiner, Art Unit 3691